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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,664	05/03/2001	Shelly E. Sakiyama-Elbert	ETH 108 CON	2552

7590 01/10/2003

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EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/848,664	Applicant(s) Sakiyama-Elbert et al.
	Examiner Michael Brannock	Art Unit 1646
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Oct 24, 2002</u>		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1, 3-7, 20, 21, 24-28, 57-59, and 61-65</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input type="checkbox"/> Claim(s) _____ is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input checked="" type="checkbox"/> Claims <u>1, 3-7, 20, 21, 24-28, 57-59, and 61-65</u> are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p>		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. <p style="margin-left: 20px;">If approved, corrected drawings are required in reply to this Office action.</p>		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). <p style="margin-left: 20px;">a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). <p style="margin-left: 20px;">*See the attached detailed Office action for a list of the certified copies not received.</p>		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). <p style="margin-left: 20px;">a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p>		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892) 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) <input type="checkbox"/> Other: _____		

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DETAILED ACTION

Status of Application: Claims and Amendments

1. Applicant is notified that the amendments put forth in Paper 8, 10/24/02, have been entered in full.

Election/Restriction

2. Claims 1, 3-7, 24-28, 57-59, 61-65 are generic to a plurality of disclosed patentably distinct species of compositions, each comprising a substrate of either fibrin, hydrogel, collagen etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Each composition comprising a substrate being a chemically distinct molecule and defining a patentably distinct invention, one not being required for the use of any other. Further, although a search of one substrate might overlap that of another, no two searches would be co-extensive, and to search all of the inventions in a single application would be unduly burdensome.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

3. Claims 1, 3-7, 20, 21, 24-28, 57-59, 61-65 are generic to a plurality of disclosed patentably distinct species of compositions, each comprising a heparin-like compound, e.g. dextran sulfate, chondroitin sulfate, heparin sulfate, fucan alginate, etc. Applicant is required under 35 U.S.C. 121 to elect a single particular disclosed molecular species of compound, even though this requirement is traversed. Each composition comprising a compound being a chemically distinct molecule and defining a patentably distinct invention, one not being required for the use of any other. Further, although a search of one of the compositions might overlap that of another, no two searches would be co-extensive, and to search all of the inventions in a single application would be unduly burdensome.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Claims 1, 3-7, 20, 21, 24-28, 57, 58, 61-65 are generic to a plurality of disclosed patentably distinct species of compositions, each comprising a particular growth factor, e.g. neurturin, persephin, IGF-1A, IBF-1 β , NT-3, BDNF, NT-4, TGF- β 3, TGF- β 4, etc. Applicant is required under 35 U.S.C. 121 to elect a single particular disclosed molecular species of growth factor, even though this requirement is traversed. Each composition comprising a growth factor being a chemically distinct molecule and defining a patentably distinct invention, one not being required for the use of any other. Further, although a search of one of the compositions might overlap that of another, no two searches would be co-extensive, and to search all of the inventions in a single application would be unduly burdensome.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB

1/6/03

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Yvonne Epler
YVONNE EPLER
SUPER EXAMINER
TECHNOLOGY CENTER 1600